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EXAMINER
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MARTINELL, JAMES

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1634

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/920,953  
Filing Date: August 02, 2001  
Appellant(s): DENG ET AL.

**MAILED**

**JUN 28 2007**

**GROUP 1600**

Gautam Prakash, Ph.D.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 12, 2007 appealing from the Office action mailed October 10, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

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## **(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

- (a) Serial No. 09/619,643; Board of Patent Appeals and Interferences No. 2002-2046; Federal Circuit Case No. 04-1465; *Ex parte* Fisher, 72 USPQ2d 1020 (Board of Patent Appeals and Interferences 2004); *In re* Fisher, 421 F.3d 1365 (Fed. Cir. 2005),
- (b) Serial No. 09/684,016,
- (c) Serial No. 10/361,942, and
- (d) Serial No. 09/199129.
- (e) Serial No. 09/615,606; Appeal 2006-3376, decided February 28, 2007.

## **(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

## **(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

- (a) Appellants refer to page 6, lines 34-35 as disclosing the subject matter of independent claim 11. It is noted that a more relevant discussion of the subject matter of claim 11 occurs in the specification at page 3, lines 3-5.
- (b) Appellants refer to page 7, lines 7-3 as disclosing the subject matter of independent claim 12. It is noted that a more relevant discussion of the subject matter of claim 12 occurs in the specification at page 7, lines 7-31.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-15 are rejected under 35 U.S.C. § 101 because the claimed invention lacks patentable utility. The instant application does not disclose a specific, substantial, and credible utility for SEQ ID NO: 2 or for any polypeptide that is encoded by SEQ ID NO: 2. Table 1 shows that SEQ ID NO: 2 encodes a polypeptide that is 81% identical to the 60S ribosomal protein L10 of *Solanum melongena*. The instant application does not disclose a patentable utility for either SEQ ID NO: 2 or any polypeptide encoded by SEQ ID NO: 2. In addition, a patentable utility is not readily apparent to one of skill in the

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art based upon the disclosure in the instant application and what was known in the art as of the effective filing date of the instant claims. For example, see the Office action mailed March 10, 2004, page 4, first full paragraph. Appellants' arguments (brief filed March 12, 2007, pages 4-9, section B) are not convincing. Appellants assert (Brief, paragraph bridging pages 4-5) that the specification at page 9, lines 15-17 and page 68 (Table 1) discloses that SEQ ID NO: 2 encodes 60S ribosomal protein L10 or a fragment thereof. However, no mention of SEQ ID NO: 2 or what it may or may not encode is seen at page 9, lines 15-17 of the specification in the instant application. Page 9, lines 15-17 states, "The BLAST program uses as defaults a wordlength (W) of 11, the BLOSUM62 scoring matrix (see Henikoff, Proc. Natl. Acad. Sci. USA 89: 10915-10919(1992)) alignments (B) of 50, expectation (E) of 10, M=5, N=4, and a comparison of both strands. The term BLAST refers to the BLAST algorithm which performs a statistical". It is accurate that Table 1 shows that SEQ ID NO: 2 encodes a polypeptide that is 81% identical to the 60S ribosomal protein L10 of *Solanum melongena*.

Appellants go on to assert that one of skill in the art "would readily recognize that the claimed nucleic acid molecules and cells have utility, for example, to encode a 60S Ribosomal Protein L10 or to modify the expression of 60S Ribosomal Protein L10 in a transformed cell." That one of skill in the art would recognize that a transformed cell could be produced using SEQ ID NO: 2 is not contested here. What is at issue is whether such a "utility" is a patentable utility that meets the criteria of 35 U.S.C. § 101. Appellants repeatedly assert that SEQ ID NO: 2 encodes a 60S Ribosomal Protein L10 or a fragment thereof (Brief filed March 12, 2007, page 4, lines 20-23; page 5, lines 1-3; page 6, lines 16-17; page 6, lines 20-23; page 7, lines 1-2; page 7, lines 7-8; and page 9, lines 1-5) and that that fact alone is sufficient to establish a specific, substantial, and credible utility for the claimed polynucleotides and transformed host cells. It remains that Appellants have identified just what real world application or utility or just what public benefit follows from knowing that SEQ ID NO: 2 encodes a 60S Ribosomal Protein L10.

It is reiterated here that applicants confuse the identification of a function of a protein with a patentable utility under 35 U.S.C. § 101 (Final rejection mailed October 10, 2006, page 4). Appellants

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assert that this statement misses the point (Brief filed March 12, 2007, page 5, line 13. This assertion is most unconvincing because it is exactly the point of this rejection that merely knowing the identity of a polypeptide that has no substantial utility as the molecule encoded by the claimed polynucleotides and included in the claimed transformed host cells is insufficient to meet the utility standard under 35 U.S.C. § 101. It is the USPTO that determines and applies the grounds for rejection, not Appellants. Appellants have not shown where the application as filed discloses a substantial utility for SEQ ID NO: 2 or any polypeptide encoded by SEQ ID NO: 2. Appellants have not disclosed a substantial utility for SEQ ID NO: 2 or any polypeptide encoded by SEQ ID NO: 2 in any of their arguments. Appellants have not shown how or why one of skill in the art would arrive at a substantial utility for SEQ ID NO: 2 or any polypeptide encoded by SEQ ID NO: 2 in any of their arguments. Appellants have not cited any authority for the notion that mere identification of the polypeptide or the function of the polypeptide encoded by a polynucleotide is sufficient to meet the utility standard under 35 U.S.C. § 101.

The statement that only one identifiable benefit to is needed to satisfy 35 U.S.C. § 101 (Brief filed March 12, 2007, paragraph bridging pages 5-6) is correct, but what is lacking in the instant application is one identifiable benefit to the public. Appellants recognize that "some *immediate benefit to the public*" is required (Brief filed March 12, 2007, page 6, line 8), yet nearly six years after the effective filing date of the instant claims, that immediate benefit remains a mystery in this record.

Appellants assert that the utility of SEQ ID NO: 2 should be considered to be well-established because 60S Ribosomal Protein L10 is a well-known, established protein. Leaving aside the lack of a cogent definition of a "well-established protein", this assertion is unconvincing and not relevant. Appellants cite (Brief filed March 12, 2007, page 7, second full paragraph) a website that they claim was accessed on February 22, 2007 (more than five years after the effective filing date of the instant claims). This citation has no meaning here because the putative evidence does not establish what was known as of the effective filing date of the instant claims. In addition, the website is improperly used because: (a) it does not meet the requirements outlined in MPEP 1206 and (b) there is no copy of what was accessed on the website in this record. Accordingly, this putative untimely filed evidence of which there is no copy

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in this record has been given no weight at all. However, to dispose of this issue and to expedite prosecution, the Examiner gives Official Notice that 60S Ribosomal Protein L10s have been known in microorganisms for at least thirty years. The issue here is whether such proteins have a substantial utility under 35 U.S.C. § 101 and that issue should not be clouded by assertions of whether such proteins were known or how long they were known. What is needed is knowledge of their utility under 35 U.S.C. § 101 and that is what is lacking in this record.


Finally, Appellants' argument citing *In re Oetiker* (Brief filed March 12, 2007, paragraph bridging pages 7-8) that "when a patent application claiming a nucleic acid asserts a specific, substantial, and credible utility and bases the assertion upon homology to existing nucleic acids or protein having an accepted utility, the asserted utility must be accepted by the examiner . . . " is not convincing because in the instant application there is no accepted utility for the protein in question. Thus, the facts here are distinguished from those in *In re Oetiker*.

Claims 1-4 and 6-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The discussions under the rejection under 35 U.S.C. § 101 are incorporated here. Since the claimed invention lacks utility under 35 U.S.C. § 101, the instant application does not teach how to use the invention.

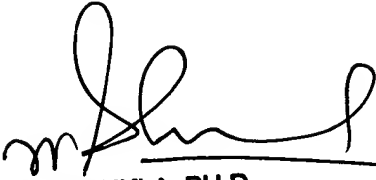
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
James Martinell  
Primary Examiner  
Art Unit 1634  
6/19/07

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